

Remarks/Arguments

Reconsideration of the above-identified application in view of the present amendment is respectfully requested. By this amendment, claims 1, 5, 9, and 10 are amended. Claims 1 and 3-11 are currently pending

I. Rejection of claims 1 and 3-11 under 35 U.S.C. 112

Claim 1 as amended recites at line 8 that "the screen (1) has an elongated shape with a length". This provides sufficient antecedent basis for the limitation "the length of the screen" at line 15. Claim 5 is amended to change "a second end portion (1c)" to "said end portion (1c)" to be consistent with the "end portion (1c)" referenced in claim 1. Claim 10 is amended to delete the language that "the refuse sack is a plastic sack from which the screen (1) can be removed and which can be tied up after removal from the screen (1)". Thus, the rejection of claims 1 and 3-11 under 35 U.S.C. 112 should be withdrawn.

II. Rejection of claims 1 and 3-11 under 35 U.S.C. 103(a)

Claims 1 and 3-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,803,299 to Sealy, Jr. ("Sealy"). Withdrawal of these rejections is respectfully requested in view of the following reasons.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 35 U.S.C. § 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains.” In making a determination of obviousness under 35 U.S.C.

§103(a):

...the scope and contents of the prior art are determined; the differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. Graham v. John Deere, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966).

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.* KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727; 2007 U.S. Lexis 4745, 36-37; 75 U.S.L.W. 4289; 82 U.S.P.Q.2d 1385, 1396 (2007) (emphasis added). Also, the U.S. Supreme Court in KSR Int’l. Co. V. Teleflex, Inc. noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the manner claimed.” *Id.*, 82 U.S.P.Q.2d at 1396.

Claim 1 recites that the screen is compressible from a normal shape to a narrower shape for threading a refuse sack onto the screen or inserting the screen into the refuse sack, the screen thereafter being brought to spring out from the narrower shape to the normal shape for stretching the refuse sack. Sealy does not disclose or suggest this subject matter.

Sealy discloses an adjustable bag insert 15 (Fig. 17) that can be mounted at the top of a container body 2. The bag insert 15 is made of deformable material and

includes notches 16 and adjusting tabs 17 so that the bag insert 15 can be adjusted to selected diameters (see Col. 5, line 19 to Col. 6, line 6). The bag insert 15 does not spring out and return to the original position for stretching the trash bags 13 or container body 2, when the bag insert 15 is fitted in the container body 2 and is locked therein by the notches 16 and tabs 17.

Further, the bag insert 15 is not compressible to a narrower shape for inserting into the trash bag 13 or for threading a trash bag 13 onto it. Rather, the trash bags 13 are positioned inside the bag insert 15 and suspended in the container interior 2a. After the innermost trash bag 13 has been filled to capacity with trash, the bag is then removed from the supports 9, gathered, sealed, and lifted from the container, leaving the next trash bag 13 in position to receive trash (see Col. 4, lines 36-41). The bag insert 15 is not inserted into the trash bag 13 or for threading a trash bag onto it.

Moreover, claim 1 recites that the screen holds the refuse sack so that the sack can stand upright on a support. Sealy does not disclose or suggest this subject matter. Clip portions 9b on the bag insert 15 are used for suspending the bag insert 15 on the container body 2. Support pegs 9 on the bag insert 15 are used for suspending the trash bag 13 in the container body 2 (Col. 6, lines 9-12). The bag insert 15 of Sealy cannot be placed on a support so that the trash bag 13 stands upright. It must be used together with the container body 2.

Further, claim 1 recites that the pins extend from the end portion in a direction substantially along the length of the screen. Sealy does not disclose or suggest this subject matter. The Examiner also admits this, but argues that "it would have been

obvious to one of ordinary skill in the art, at the time the invention was made, to construct the screen of Sealy where the portion from which the pins extend is an end portion since rearranging of parts of an invention involves only routine skill in the art".

However, the U.S. Supreme Court in KSR Int'l. Co. V. Teleflex, Inc. clearly stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art". Id., 82 U.S.P.Q.2d at 1396. As previously mentioned, the court noted that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the manner claimed." Id., 82 U.S.P.Q.2d at 1396. Also, the board of patent appeals and interferences held that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). In the present rejection of claim 11, the Examiner does not provide any motivation or reason to rearrange the pegs 9 of Sealy to extend from an end portion.

Further, there is no motivation or reason to rearrange the pegs 9 of Sealy to extend from an end portion. In fact, one of ordinary skill in the art would be lead away from rearranging the pegs 9 to extend from an end portion for several reasons. First, the pegs 9 are more likely to be damaged if they extend from an end portion since they would be outside of the container interior 2a and more exposed to the

environment. Furthermore, to extend the pegs 9 of Sealy from an end portion would make it more difficult to remove a filled innermost bag 13 from the pegs, since the bag must be separated from the other bags and then lifted up over the pegs for removal. This action could also tear the bag near the slots of the bag. By contrast, the extension of the pegs 9 into the container interior 2a allows the filled bag 13 to be removed by simply sliding the slots of the bag off the pegs in the inward direction. Hence, tears on the bags 13 are more likely to occur if the pegs extend from an end portion.

Therefore, for the reasons set forth above, the rejection of claim 1 under 35 U.S.C. 103(a) as being obvious over Sealy fails to establish a prima facie case for obviousness. Thus, claim 1 is allowable.

Claims 3-7 and 10 depend from claim 1 and are therefore allowable as depending from an allowable claim and for the specific features recited therein.

Claim 8, which depends from claim 1, should be allowed for the same reasons as claim 1 and also for the additional structural features in which longitudinal edges of the screen are designed or include members for preventing damage of the refuse sack by the longitudinal edges. Sealy does not disclose or suggest this subject matter. The container 2 of Sealy is merely used for supporting and suspending multiple, nested trash bags (see abstract and Col. 2, lines 35-60). There is no indication that Sealy discloses any longitudinal edges of the bag insert 15 that are designed or include members for preventing damage of the trash bags 13 by the longitudinal edges. The allegation of the Examiner that "the longitudinal edges are capable of being designed for preventing damage of the refuse sack by the

longitudinal edges" does not mean that Sealy discloses or suggests this feature.

Therefore, claim 8 is allowable.

Claim 9 is amended to replace "can be" with --is- at line 2 and with --are-- at line 5. Claim 9, which depends from claim 1, should be allowed for the same reasons as claim 1 and also for the additional feature in which a strip is hooked onto two longitudinal edges of the screen such that the strip extends across an opening between the longitudinal edges at a second end portion of the screen and that the open parts of the refuse sack are folded within the strip. Sealy does not disclose or suggest this feature. There is no indication in Sealy that a strip is hooked onto two longitudinal edges of the bag insert 15 such that the strip extends across an opening between the longitudinal edges at a second end portion of the bag insert 15 and that the open parts of the trash bag 13 are folded within the strip. Even the allegation of the Examiner that "a strip is capable of being hooked onto two longitudinal edges of the screen such that the strip extends across an opening between the longitudinal edges at a second end portion of the screen and the open parts of the refuse sack can be folded within the strip" does not mean that Sealy discloses or suggests this feature. This allegation is speculative. In fact, anything extending across the opening of the bag insert 15 could interfere with the filling or removal of the inner most trash bag 13. Therefore, claim 9 is allowable.

Independent claim 11 recites an elastic panel member that is compressible from a first shape to a second, narrower shape for inserting the panel member into the refuse sack, the panel member flexing outwardly from the second shape toward

the first shape thereby stretching the refuse sack. Sealy does not disclose or suggest this subject matter.

Sealy discloses an adjustable bag insert 15 that can be mounted at the top of a container body 2. The bag insert 15 is made of deformable material and includes notches 16 and adjusting tabs 17 so that the bag insert 15 can be adjusted to selected diameters (see Col. 5, line 19 to Col. 6, line 6). The bag insert 15 does not flex outward and return to the original position for stretching the trash bags 13, when the bag insert 15 is fitted in the container body 2 and is locked therein by the notches 16 and tabs 17.

Further, the bag insert 15 is not compressible for inserting into the trash bag 13. Rather, the trash bags 13 are positioned inside the bag insert 15 and suspended in the container interior 2a. After the inner most trash bag 13 has been filled to capacity with trash, the bag is then removed from the supports 9, gathered, sealed and lifted from the container, leaving the second inner bag in position to receive trash (see Col. 4, lines 36-41). The bag insert 15 is not inserted into the trash bag 13.

Moreover, claim 11 recites that the pins extend from the end portion in a direction substantially along the length of the screen. Sealy does not disclose or suggest this subject matter. The Examiner also admits this, but argues that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to construct the screen of Sealy where the portion from which the pins extend is an end portion since rearranging of parts of an invention involves only routine skill in the art".

However, the U.S. Supreme Court in KSR Int'l. Co. V. Teleflex, Inc. clearly stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art". Id., 82 U.S.P.Q.2d at 1396. As previously mentioned, the court noted that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the manner claimed." Id., 82 U.S.P.Q.2d at 1396. Also, the board of patent appeals and interferences held that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). In the present rejection of claim 11, the Examiner does not provide any motivation or reason to rearrange the pegs 9 of Sealy to extend from an end portion.

Further, there is no motivation or reason to rearrange the pegs 9 of Sealy to extend from an end portion. In fact, one of ordinary skill in the art would be lead away from rearranging the pegs 9 to extend from an end portion for several reasons. The pegs 9 are more likely to be damaged if they extend from an end portion since they would be outside of the container interior 2a and more exposed to the environment. Furthermore, to extend the pegs 9 of Sealy from an end portion would make it more difficult to remove a filled innermost bag 13 from the pegs, since the bag must be separated from the other bags and then lifted up over the pegs for

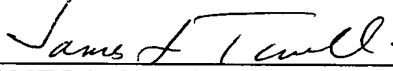
removal. This action could also tear the bag near the slots of the bag. By contrast, the extension of the pegs 9 into the container interior 2a allows the filled bag 13 to be removed by simply sliding the slots of the bag off the pegs in the inward direction. Hence, tears on the bags 13 are more likely to occur if the pegs extend from an end portion.

Therefore, for the reasons set forth above, the rejection of claim 11 under 35 U.S.C. 103(a) as being obvious over Sealy fails to establish a prima facie case for obviousness. Thus, claim 11 is allowable.

In view of the foregoing, it is respectfully requested that the amendment be entered and the application allowed.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



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